

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: David S. Stutz and Christopher A. Zimmerman

Title: METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT CONNECTIONS
Docket No.: 777.115USR

BOX PATENT APPLICATIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

We are transmitting herewith the following attached items (as indicated with an "X"):

- A Communication Re: Transmittal of Reissue Application (2 pgs).
 A Reissue Application including Specification, Claims, Abstract and Drawings (38 pgs).
 A Declaration of Inventors (Unsigned) (3 pgs).
 Offer to Surrender Original Patent (1 pg).
 Assent by Assignee Under 37 C.F.R. 1.172 and Power of Attorney (2 pgs).
 Request to Transfer Drawings (1 pg).
 Preliminary Amendment (3 pgs).
 A check in the amount of \$790.00 to cover the Reissue Filing Fee.
 A return postcard
- Other: _____

- The filing fee has been calculated below as follows:

CLAIMS AS FILED					
	(1) No. Filed		(2) No. Extra	Rate	Fee
BASIC FEE	XXXXX		XXXXX	XXXXX	\$790.00
TOTAL CLAIMS	1 - 20	=	0	x 22 =	\$0.00
INDEPENDENT CLAIMS	1 - 3	=	0	x 82 =	\$0.00
[] MULTIPLE DEPENDENT CLAIMS PRESENTED					\$0.00
TOTAL					\$790.00

If the difference in Column (1) is less than zero, enter "0" in Column (2).

Please charge any additional required fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938, Minneapolis, MN 55402 (612-373-6900)

By: 
Atty: Sheryl Sue Holloway
Reg. No. 37,850

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EM153178762US

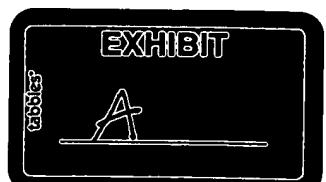
Date of Deposit: January 16, 1998

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, BOX PATENT APPLICATIONS, Washington, D.C. 20231.

By: Valerie Studer
Name: Valerie Studer

(NEW FILING)

EM153178762US



REISSUE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David S. Stutz et al.

Serial No.: Unknown

Filed: Concurrently Herewith Docket: 777.115USR

Title: METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT
CONNECTIONS

COMMUNICATION RE: TRANSMITTAL OF REISSUE APPLICATION

BOX PATENT APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Please find enclosed herewith an application for reissue of U.S. Patent No. 5,485,617, issued on January 16, 1996, to David S. Stutz and Christopher A. Zimmerman and entitled "METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT CONNECTIONS", which reissue application includes the following:

1. Reissue Application including Specification, Claims, Abstract, and Drawings;
2. Declaration of Inventors (Unsigned)
3. Offer to Surrender Original Patent;
4. Assent by Assignee under 37 C.F.R. §1.172 and Power of Attorney;
5. Request to Transfer Drawings and copy of drawings as printed in patent of parent application;
6. Preliminary Amendment; and
7. A check to pay the reissue filing fee and a check to pay the Title Report fee.
8. A return postcard.

Please charge any additional required fees, or credit overpayment, to Deposit Account
No. 19-0743.

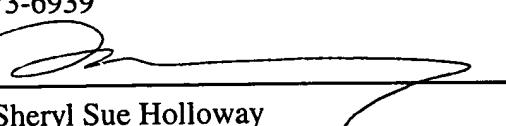
Respectfully submitted,

DAVID S. STUTZ ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6939

Date Jan. 16, 1998

By 

Sheryl Sue Holloway
Reg. No. 37,850

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EM153178762US

Date of Deposit: January 16, 1998

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Valerie Strader

Name

Valerie Strader

Signature

In re Patent Application of: David S. Stutz et al.

Title: METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT
CONNECTIONS

Docket No.: 777.115USR

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Receipt is hereby acknowledged for the following in the United States Patent and
Trademark Office:

CONTENTS: A Communication Re: Transmittal of Reissue Application (2 pgs); A
Reissue Application including Specification, Claims, Abstract and Drawings (38 pgs); A
Declaration of Inventors (Unsigned) (3 pgs); Offer to Surrender Original Patent (1 pg);
Assent by Assignee Under 37 C.F.R. 1.172 and Power of Attorney (2 pgs); Request to
Transfer Drawings (1 pg); Preliminary Amendment (3 pgs) a check in the amount of \$790.00
to cover the Reissue Filing Fee; and TRANSMITTAL SHEET.

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EXHIBIT

B

REISSUE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David S. Stutz et al

Serial No.: Unknown

Filed: Concurrently Herewith

Docket: 777.115USR

Title: METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT CONNECTIONS

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Prior to examination of the above-identified patent application, please amend the above-identified patent application as follows:

IN THE CLAIMS

Please amend the claims as follows:

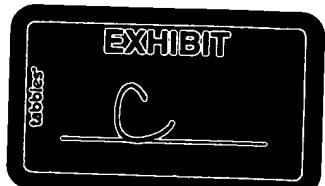
46. [New] A computer-readable medium having computer-executable instructions for performing steps to generate an object connection between a source object and a sink object, the sink object implementing a plurality of notification interfaces for communicating with the sink object, each notification interface having an associated interface identifier, and the source object having instances of a connection point interface, each instance of the connection point interface having an associated interface identifier, the steps comprising:

selecting a notification interface from among the plurality of notification interfaces of the sink object;

selecting an instance of the connection point interface of the source object, the selected instance having an associated interface identifier which corresponds to the interface identifier associated with the selected notification interface of the sink object;

using the selected connection point interface instance to request that the source object and the sink object be connected, wherein the request has a reference to an instance of the selected notification interface of the sink object; and

storing the reference to the instance of the selected notification interface, so that the sink object can be notified by the source object.



47. [New] A computer-readable medium having stored thereon an object connection architecture comprising:

 a plurality of sink objects, each sink object having a notification function member for communicating with the sink object from a source object; and

 a plurality of source objects, each source object having a plurality of connection point objects, each connection point object storing a plurality of notification function members and returning an identification of one of the notification function members from the stored plurality of notification function members upon request.

REMARKS

Entry of the above amendment is respectfully requested. Applicant respectfully submits that new claims 46 and 47 do not represent new matter as they contain the elements of U.S. Patent No. 5,485,617 claims 27 and 39, respectively, claimed in an article of manufacture format. A computer-readable medium is supported in the 5,485,617 patent at column 9, lines 15-18 which describes a computer system suitable for implementing Applicant's invention. The elements of both claims are supported, in general, by the originally-filed specification of the 5,485,617 patent. In particular, claim 45 is supported at column 15, line 38 through column 16, line 28, and claim 47 is supported in at column 9, line 60 through column 10, lines 10.

Respectfully submitted,

DAVID S. STUTZ ET AL

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6939

Date Jan. 16, 1998

By

Sheryl Sue Holloway
Reg. No. 37,850

CERTIFICATE UNDER 37 CFR 1.10:

CERTIFICATE UNDER 37 CFR 1.10. "Express Mail" mailing label number: EM153178762US

Express Mail mailing label number: EM1176762
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Valerie Spader

Name _____

Signature

Signature

FILING RECEIPT

CORRECTED



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
09/008,241	01/16/98	2755	\$1,128.00	777.115USR	10	1	1

SCHWEGMAN LUNDBERG WOESSNER AND KLUTH
P O BOX 2938
MINNEAPOLIS MN 55402

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Application Processing Division's Customer Correction Branch within 10 days of receipt. Please provide a copy of the Filing Receipt with the changes noted thereon.

Applicant(s)

DAVID S. STUTZ, REDMOND, WA; CHRISTOPHER A. ZIMMERMAN,
BELLEVUE, WA.

CONTINUING DATA AS CLAIMED BY APPLICANT-
THIS APPLN IS A RE OF 08/166,976 12/13/93 PAT 5,485,617

FOREIGN FILING LICENSE GRANTED 03/02/98

TITLE

METHOD AND SYSTEM FOR DYNAMICALLY GENERATING OBJECT CONNECTIONS

PRELIMINARY CLASS: 395



In re Richard N. BENNETT.**Appeal No. 84-778.**United States Court of Appeals,
Federal Circuit.

June 28, 1985.

Appeal was taken from decision of the United States Patent & Trademark Office Board of Appeals which rejected claims of reissue patent application. The Court of Appeals, Pauline Newman, Circuit Judge, held that broadening reissue application which was filed within two-year period for applications seeking to enlarge scope of claims but was defective because it was not executed by the inventor could be corrected after expiration of two-year period by inventor's filing substitute declaration.

Reversed.

Nies, Circuit Judge, filed concurring opinion in which Bissell, Circuit Judge, joined.

Jack R. Miller, Senior Circuit Judge, filed dissenting opinion in which Skelton, Senior Circuit Judge, and Kashiwa, Circuit Judge, joined.

1. Patents \Leftrightarrow 141(4)

Proposed reissue claims to machine for filling containers with fluid sought to enlarge scope of claims of original patent where original claims described "continuously running conveyor means" and reissue application introduced claims to "conveyor means." 35 U.S.C.A. § 251.

2. Patents \Leftrightarrow 141(3)

Claim is broadened if it is broader in any respect than original claim, even though it may be narrowed in other respects. 35 U.S.C.A. § 251.

* Judge Miller assumed senior status on June 6, 1985, but was on active status when this case was submitted.

3. Patents \Leftrightarrow 140

Execution of broadening reissue application by assignee's president instead of by inventor did not comply with requirements of 35 U.S.C.A. § 251, relating to reissue patents.

4. Patents \Leftrightarrow 140

Broadening reissue application which was filed within two-year period for applications seeking to enlarge scope of claims but was defective because it was not executed by the inventor could be corrected after expiration of the two-year period by inventor's filing of substitute declaration. 35 U.S.C.A. §§ 26, 116, 251, 256; Practice Rules in Patent Cases, Rule 122(a), 35 U.S.C.A. App.

Paul M. Craig, Jr., Craig & Burns, Washington, D.C., argued for appellant. With him on brief was Frederick F. Calvetti.

Henry W. Tarring, III, Associate Sol., U.S. Patent and Trademark Office, Arlington, Va., argued for appellee. With him on brief were Joseph F. Nakamura, Sol. and Jere W. Sears, Washington, D.C.

Before MARKEY, Chief Judge, FRIEDMAN, RICH, DAVIS, Circuit Judges, SKELTON, Senior Circuit Judge, BALDWIN, KASHIWA, BENNETT, MILLER,* Senior Circuit Judge, SMITH, NIES, NEWMAN, and BISSELL, Circuit Judges.**

PAULINE NEWMAN, Circuit Judge.

This appeal is from the decision of the United States Patent and Trademark Office (PTO) Board of Appeals (Board), rejecting claims 24-39 of reissue patent application Serial No. 036,745 of Richard N. Bennett under 35 U.S.C. § 251, on the ground that a broadening reissue application that was filed within two years of the patent's issue date but was erroneously filed by the assignee could not be corrected by a declaration of the inventor filed more than two

** This appeal was argued before a panel consisting of Miller, *Circuit Judge*, Skelton, *Senior Circuit Judge*, and Newman, *Circuit Judge*. The court at its initiative considered the case *in banc*.

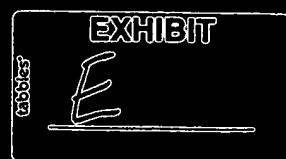
years after the reverse.

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The application teen months after patent, and was Rosen as preside Company, identi as the inventor after, hence thir nal application w Office Action inf the reissue appl the scope of the be signed by tl with 35 U.S.C. § inventor, Richard mitted. The Ex: ration, but rejec Appellant advise pose of the reiss before the PTO considered, but i

The Board rejections on prio C.F.R. § 1.196(b acceptance of B: tion, stating th failed to comply 35 U.S.C. § 251



years after the patent's issue date. We reverse.

Background

The application at bar was filed on May 7, 1979 for reissue of U.S. Patent No. 4,078,322 for a "High Speed Filling Machine" issued February 14, 1978 to National Instrument Company, Inc. as assignee of Richard N. Bennett. The invention is a machine for filling containers with fluid, which by its structure and operation is asserted to increase the filling rate substantially as compared with previously known machines. It is pertinent that the claims as issued describe a "continuously running conveyor means" and a "continuously running, in operation, conveyor belt". The reissue application introduced new claims which used the unqualified words "conveyor means". A purpose of the change to "conveyor means" was to cover intermittent as well as continuous running of the conveyor.

The application for reissue was filed fifteen months after the grant of the original patent, and was executed by Mr. Sidney Rosen as president of National Instrument Company, identifying Richard N. Bennett as the inventor. Fifteen months thereafter, hence thirty months after the original application was issued, the PTO's first Office Action informed appellant that since the reissue application sought to enlarge the scope of the claims it was required to be signed by the inventor in accordance with 35 U.S.C. § 251. A declaration by the inventor, Richard N. Bennett, was submitted. The Examiner accepted this declaration, but rejected the claims on prior art. Appellant advises that the principal purpose of the reissue application was to bring before the PTO prior art not previously considered, but raised in pending litigation.

The Board reversed the Examiner's rejections on prior art, but pursuant to 37 C.F.R. § 1.196(b) reversed the Examiner's acceptance of Bennett's substitute declaration, stating that the application as filed failed to comply with the requirements of 35 U.S.C. § 251, and that the matter was

not correctable, distinguishing *A.F. Stoddard & Co., Ltd. v. Dann, Commissioner of Patents*, 564 F.2d 556, 195 USPQ 97 (D.C.Cir.1977) (Markey, C.J., sitting by designation).

The pertinent paragraphs of 35 U.S.C. § 251 provide:

[¶ 3]: The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

[¶ 4]: No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

I.

[1] Appellant first challenges the Board's conclusion that some of the proposed reissue claims seek to enlarge the scope of the claims of the original patent. Appellant contends that the Board admitted that the difference in description of the conveyor is directed to a non-essential feature which adds no patentability to the claims, and points to the Examiner's statement that "[t]he claimed combination with an intermittent moving conveyor is not patentably distinct from the claimed combination with a continuously running conveyor". Appellant argues further that other parts of the claims were limited, so that overall the claims are not of enlarged scope.

The declaration of Mr. Rosen as president, accompanying the reissue application, stated that the original patent contained "limitations unduly restrictive" and that it "failed to cover the modified structure disclosed" in the specification. The subsequent declaration of Richard Bennett acknowledged that newly submitted claim 24 was "broader than claim 23".

[2] As stated in *In re Rogoff*, 261 F.2d 601, 603-04, 120 USPQ 185, 186 (CCPA

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1958), "a claim is broadened if it is broader in any respect than the original claim, even though it may be narrowed in other respects". *See also Ball Corp. v. United States*, 729 F.2d 1429, 1438, 221 USPQ 289, 296 (Fed.Cir.1984), and citations therein.

[3] The Board correctly concluded that the reissue application contains broadened claims. "Conveyor means" is broader in scope than "a continuously running, in operation, conveyor belt". It is immaterial whether the claimed invention with an intermittently moving conveyor is patentably distinct from one with a continuously running conveyor, for it is plain that "conveyor means" is broader than both. We also agree with the Board that the execution of the broadening reissue application by the assignee's president instead of by the inventor did not comply with 35 U.S.C. § 251.

[4] The reissue application was filed within the two-year period set in 35 U.S.C. § 251, fourth paragraph, for applications which seek to enlarge the scope of the claims. The question before us does not concern the addition of broadened claims after the two years had passed, as discussed in *In re Doll*, 419 F.2d 925, 164 USPQ 218 (CCPA 1970). The sole question is whether the defective execution of the timely filed reissue application may be corrected after those two years had passed.

The declaration accompanying the application identified Richard N. Bennett as the inventor; its flaw is that the request for reissue was signed only by an officer of the patent owner, and not also by Mr. Bennett. 35 U.S.C. § 251, third paragraph, authorizes an assignee of the entire interest in a patent to apply for a reissue to correct errors and to narrow the scope of the claims, without oath or declaration or concurrence by the inventor. Signature of the inventor is required only when the reissue seeks to enlarge the scope of the claimed invention, by analogy to the requirement that the inventor sign an original application for patent:

The provisions of this title relating to applications for patent shall be applicable to applications for reissue....

Nevertheless Mr. Bennett, the inventor, could not have applied for the reissue on his own, whether or not the application sought broadened claims, as the signature of a representative of National Instrument Co. was a necessary part of any reissue application. 37 C.F.R. § 1.172(a).

The Board concluded that the substitute declaration by the inventor Bennett, which was filed more than two years after the grant of the original patent, could not cure the defect in the reissue application, citing the absence of statutory authorization to the PTO to correct the defect. We hold that the patent statute and judicial precedent require a contrary result.

II.

Several provisions of the patent law enable correction of errors, to avoid jeopardizing a patent-seeker's rights and interest. 35 U.S.C. § 26, for example, provides:

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

The legislative history of this section attests that Congress had in mind the dangers that overly-rigid bureaucratic practices could and did pose for patent applicants. The House Report states that before enactment of this provision, an irregularity in a patent application could bring the application process to a halt. This could "jeopardize the date of priority of ... invention" and result in "serious repercussions, including the loss of patent rights" H.R. Rep. No. 1181, 88th Cong., 2d Sess. 2, reprinted in 1964 U.S.Code Cong. & Admin.News 2122, 2123. Note also the amendment to allow late payment of issue fees, discussed in S.Rep. 1401, 93d Cong., 2d Sess. 2, reprinted in 1974 U.S.Code Cong. & Admin.News 7137, 7138, whereby 35 U.S.C. § 151 was amended to "eliminate

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need for private bills seeking relief from the rigorous application of existing law".

The principle behind such remedial provisions is to allow correction of those statutory rigors for which the penalty may be excessive under the circumstances. These relief provisions attempt to strike a balance between the need for consistency in administration of a complex statute, even if consistency occasionally results in forfeiture of substantive rights, and the need for fairness, which may place on the administering body the occasional burden of exercising discretion to avoid an unjust result. The balance chosen requires continual evaluation in light of the purposes served by the statute.

It is not in the public interest to bar all possibility of legal or equitable relief, when such is sought to correct a harmless error. Thus we consider the reality of the practice at issue, guided by legislative and judicial precedent, and mindful of the interest of justice.

In *Stoddard v. Dann, supra*, the Court of Appeals for the District of Columbia Circuit applied these principles to enable correction of both an issued patent and a pending application that had mistakenly been executed by a representative of the assignee instead of by the inventor. To correct the patent, Stoddard had filed a reissue application accompanied by a declaration of the inventor to the effect that an innocent error had been made (an officer of the assignee instead of the inventor had signed the U.S. patent application); the inventor had also sought correction of the pending application. The PTO refused, stating that neither correction was authorized by statute.

The Court of Appeals reversed the PTO's decision. The court reviewed the foundations of the patent system, determined that the Constitution posed no obstacle to the corrections sought, and that "the constitutional objective of granting a patent (or a reissue patent) to the true inventor will be, and can only be, served by permitting the requested correction." 564 F.2d at 562, 195 USPQ at 102. The court observed that

35 U.S.C. § 116 contained no express prohibition against the corrections that Stoddard sought and concluded that since the parent application had been filed by an entity "capable of recognition by the PTO" there could be "no harm to the public interest in permitting the requested correction...." 564 F.2d at 565, 195 USPQ at 105.

There are striking parallels between *Stoddard* and the facts of the case at bar. Both cases involve error wherein the requirement that the application be executed by the inventor was not met, in that the applications were executed by a representative of the assignee. At issue in both cases was an invention for which a patent had already issued and the subject matter disclosed to the public, as the court in *Stoddard* said, "in accord with the constitutional objective ... even though the signature or signatures of the true inventive entity may be either incorrect or entirely absent." 564 F.2d at 565, 195 USPQ at 104.

Pertinent is the *Stoddard* court's conclusion that "[t]o permit the requested substitution of names would on this record harm no one"; and, "[t]o deny the requested correction ... would serve no useful purpose, would frustrate the constitutional objective, [and] would exalt form over substance ... all to the injury of the patent system and to him to whom it must appeal, i.e., the inventor." 564 F.2d at 564, 195 USPQ at 103-04.

In several ways Bennett's situation presents a more compelling case than that described in *Stoddard*. The *Stoddard* court allowed correction of a patent that named the assignee's representative as inventor. Bennett seeks to correct an application that named the correct inventor but was signed by the assignee's representative, for a patent which names the correct inventor. With the precedent that the former correction was permissible, surely so is the latter.

At the time *Stoddard* was decided, 35 U.S.C. § 116 read in pertinent part as follows:

Whenever a person is joined in an application for patent as joint inventor

through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

The statute made no provision for the situation which Stoddard faced. The *Stoddard* court recognized that it was addressing a situation that had "escaped specific statutory treatment." 564 F.2d at 565, 195 USPQ at 105. The court's holding was embraced in the 1982 amendment of § 116, which now reads in pertinent part as follows:

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

The legislative history of this provision makes clear its remedial intent. The House Report states that the amendment to § 116 (and to § 256 for correction of issued patents) was made "to enlarge the possibilities for correcting misnamed inventive entities. As a consequence, correction would be permitted also in cases where the person originally named as inventor was in fact not the inventor of the subject matter contained in the application. If such error occurred without any deceptive intention on the part of the true inventor, the Commissioner would have the authority to substitute the true inventor for the erroneously named person." H.Rep. No. 542, 97th Cong., 2d Sess. 9 (1982) reprinted in 1982 U.S.Code Cong. & Admin.News 765, 773. This history is at odds with the Board's position here that *Stoddard* is not pertinent decisional law or that it must be narrowly construed. Further, remedial legislation may have retrospective effect when its purpose is corrective. This court has affirmed that "amendments under § 116 and conversion of inventorship should be liberally allowed." *Coleman v. Dines*, 754

F.2d 353, 357, 224 USPQ 857, 860 (Fed.Cir. 1985).

Recognizing that all of the provisions of a unified statute must be read in harmony, the portion of section 251 which requires that a broadening reissue application must be signed by the inventor does not mean that an error in compliance with section 251 is insulated from the remedial ruling of *Stoddard* or the statutory provisions for correction of error. The purpose of the reissue statute is to remedy errors. As stated in *Ball Corp.*, 729 F.2d at 1439 n. 28, 221 USPQ at 296 n. 28, "[r]eissue is remedial in nature and is based on fundamental principles of equity and fairness." These fundamental principles must not be forgotten in implementation of the statute.

IV.

Bennett complains that he had no opportunity to correct the error within the two-year period, citing M.P.E.P. § 1442.03 which states that "[a]ll reissue applications ... will be taken up for action ahead of other 'special' applications; this means that all issues not deferred will be treated and responded to *immediately*" (emphasis in original). It appears however that there was intervening activity, including two protests, that may have contributed to the delay. We do not address this issue, which is mooted by our decision.

V.

We conclude that the Board erred in refusing to allow appellant to correct the defective execution of the reissue application which was filed within the two year period of § 251, third paragraph.

REVERSED.

NIES, Circuit Judge, with whom BISSELL, Circuit Judge, joins, concurring.

I reach the same result as the majority but from a different reading of the statute. While, under § 251, a reissue application must be filed within two years and must be supported by an inventor's oath to obtain broadened claims, I read these as separable

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1, 860 (Fed.Cir. 1985).

provisions of the statute in harmony, which requires that application must be filed within two years of the filing date. As such, nothing in section 251 precludes the broadening of claims in a reissue application. As 2d at 1439 n. 1, "[r]eissue is based on fundamental fairness." This must not be read into the statute.

had no opportunity to file applications in the two-year period. § 1442.03(e) applications were filed ahead of this means that the examiner treated and (emphasis added) that there were two prohibited to the issue, which

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provisions. In my view, the third paragraph of § 251 is a dispensation, not a requirement tied to the two year deadline. Further, nothing in §§ 111 or 115 requires participation in the filing of a reissue application by the inventor.

Where the PTO determines that claims are being broadened, as here, the assignee is not entitled to the *benefit* of the third paragraph of § 251. The oath required of the inventor in such cases is comparable, in my mind, to a supplemental oath by an inventor during original prosecution in instances where claims are broadened. Such oath, presumably for the purpose of assuring that the inventor does believe he invented what is claimed, does not change a filing date. On the other hand, the two year deadline for broadened reissue serves a different purpose—namely, to fix a specific time limit for filing a reissue application seeking broader claims, replacing the imprecise application of "laches." That purpose was fully satisfied by National's filing in this case. National's reissue application secured a filing date within the prescribed two year period, clearly negating laches. I see nothing in the requirement for an inventor's oath that expressly, or by necessary implication, takes that filing date away with respect to claims in a reissue application which are broader than issued claims, whether the broader claims are added during prosecution of the reissue application, as were the claims in issue in *In re Doll*, 419 F.2d 925, 164 USPQ 218 (CCPA 1970), or submitted in the reissue application as filed. In other words, I see no partial defective "execution" of a reissue application. National's reissue application was validly executed for the broader, as well as the narrower, claims presented

1. Appellant's evidence underscores an intention to broaden the scope of the original patent's claims. For example, appellant-assignee's Declaration of May 19, 1982, recites that limitations added by the examiner to the original patent were "unduly restrictive" and that "the original patent failed to cover the modified structure disclosed." Inventor-Bennett's own Declaration filed January 26, 1981, recites that—

[O]riginal patent claim 23 had been changed by Examiner's Amendment to "a continuously

therein. With respect to the broader claims, a supplemental inventor's oath was required which does not change the filing date.

MILLER, Senior Circuit Judge, with whom SKELTON, Senior Circuit Judge, and KASHIWA, Circuit Judge, join dissenting.

The third paragraph of 35 U.S.C. § 251 provides as follows:

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

It is clear that the board correctly ruled that the involved application was enlarged, contrary to the examiner's position that there was no patentable distinction between a "continuous" and an "intermittent" conveyor and that the language change was not the essence of the invention but merely set forth the best mode of carrying out the invention.¹ In *Ball Corp. v. United States*, 729 F.2d 1429, 1438, 221 USPQ 289, 296 (Fed.Cir.1984), this court recognized the principle (previously stated by the CCPA) that "a claim is broadened if it is broader in any respect than the original claim" even though it may be narrowed in other respects.

Appellant argues that 35 U.S.C. § 251 does not apply, because the reissue application was filed "in the name of the true inventor." However, as I read the application, it was filed in the name of "NATIONAL INSTRUMENT COMPANY, INC." (the

running, in operation, conveyor belt" which language is believed awkward and which has been changed ... that the aforementioned limitation added to claim 23 in the Examiner's Amendment dated October 20, 1977 is unduly restrictive ...; that claims 24-34 were added to correct the aforementioned deficiencies, claim 24 being broader than claim 23. See *In re Ruth*, 278 F.2d 729, 126 USPQ 155 (CCPA 1960).

assignee of the original patent), and signed "by Sidney Rosen, President."

Appellant says that the filing of said application was an error without deceptive intent, but I agree with the Solicitor that for an assignee to invoke the third paragraph of 35 U.S.C. § 251, while ignoring the basis for the exception (in the case of an application for reissue made by an assignee) set forth therein, and then to have the error excused, would render the provision regarding broadened claims a nullity. There is no evidence before this court rebutting the basic presumption that Congress shall not be deemed to have done a futile thing. *Markham v. Cabell*, 326 U.S. 404, 409, 66 S.Ct. 193, 195, 90 L.Ed. 165 (1945); *Singer v. United States*, 323 U.S. 338, 344, 65 S.Ct. 282, 285, 89 L.Ed. 285 (1945); *Armstrong Co. v. Nu-Enamel Corp.*, 305 U.S. 315, 333, 59 S.Ct. 191, 200, 83 L.Ed. 195 (1938); *Anniston Manufacturing Co. v. Davis*, 301 U.S. 337, 351, 57 S.Ct. 816, 823, 81 L.Ed. 1143 (1937); *United States v. O'Driscoll*, 761 F.2d 589 (10th Cir.1985); N.J. Singer, *Sutherland Stat. Const.* § 45.12 (4th ed. 1984). Nor is there any evidence that appellant's error was "harmless." A mere rote recital of "form over substance" does not fill the evidence void. Nor is there anything in *any* legislative history indicating Congressional intent to permit a waiver of the provision on broadened claims. In his 1954 "Commentary on the New Patent Act" (of 1952), Part III, P.J. Federico merely says: "A new provision has been added permitting the assignee of a patent to apply for a reissue provided the reissue does not seek to enlarge the claims of the original patent."²

2. Reference to 35 U.S.C. §§ 26, 116, and 256 as "remedial provisions" is not helpful. Section 26 was intended to eliminate a problem of the Patent and Trademark Office resulting from defective oaths, such as "failure to authenticate the notary's authority, and the omission or incompleteness of the date of execution." H.R. Rep. No. 1181, 88th Cong., 2d Sess. 2, *reprinted in* 1964 U.S. Code Cong. & Ad. News 2123. Section 116 has to do with inventors—not assignees. Section 256 relates to issued patents. All provide only that the Commissioner "may" take remedial action. There is no evidence that appellant's violation of section 251 was "of a mi-

Appellant argues further that the PTO should be estopped from pursuing rejection of the reissue claims because it accepted the original reissue application and gave it a filing date and serial number; also, because it violated section 1442 of the Manual of Patent Examining Procedure which directs that reissue applications be taken up "special" and issues be treated immediately.³ Assuming that these points establish an equitable argument, the short answer is that the PTO cannot deliberately or inadvertently waive the clear requirements of the statute. Appellant cites *A.F. Stoddard & Co. v. Dann, Commissioner*, 564 F.2d 556, 195 USPQ 97 (D.C.Cir.1977), as precedent for "interstitial legislation" (the involved statute, 35 U.S.C. § 116, neither authorized nor prohibited the conversion of inventorship there in issue), arguing that 35 U.S.C. § 251 "does not clearly prohibit the submittal of a declaration by the inventor in a reissue application, originally filed by the assignee, if it is determined subsequently that a claim is of 'broadened' scope." However, the third paragraph of section 251 clearly prohibits *broadened claims* in a reissue application filed by an assignee.

Appellant contends that reissue statutes, being remedial, "should be construed liberally," and (in effect) that a declaration filed by the inventor on January 26, 1981, more than two years after issuance of the original patent on February 14, 1978, should *nunc pro tunc* cure its reissue application. However, no amount of "liberalism" can justify disregard of the plain meaning of the statute. I do not regard *In re Doll*, 419 F.2d 925, 164 USPQ 218

nor character" or "harmless error." It is not for this court to "correct" a statute "in the public interest." That is the province of Congress.

3. Appellant complains of an "unexplained delay" by the PTO of fifteen months between filing of the reissue application and the first Office Action and asserts that if the PTO had acted promptly a substitute declaration could have been filed within the two-year period. However, appellant does not indicate that he or the assignee made any effort to expedite action.

(CCPA 1970), a since that case reissue application of broadening held that the fourth paragraph refers to filing and did not preclude claims to invention.

The decision is affirmed.

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Applicant a the United Stat Office Board o final rejection o tion relating to suitable for pr form shaped ob molded parts. R. Miller, Senic the claims were pated.

Affirmed.

1. Patents

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ther that the PTO in pursuing rejection because it accepted application and gave it number; also, before 1442 of the Manual of Procedure which directions be taken up treated immediate- these points establish the short answer is deliberately or inad- ar requirements of sites *A.F. Stoddard Missioner*, 564 F.2d Cir. 1977), as pre- cipulation" (the in- § 116, neither au- the conversion of sue), arguing that not clearly prohibit ation by the invention, originally filed determined subse- is of 'broadened' third paragraph of prohibits *broadened* ation filed by an

(CCPA 1970), as precedent to the contrary since that case concerned a correctly filed reissue application and the subsequent addition of broadened claims. The court simply held that the language "applied for" in the fourth paragraph of 35 U.S.C. § 251 refers to filing of an application for reissue and did not prohibit the addition of broadened claims to the correctly filed application.

The decision of the PTO should be affirmed.



In re John A. DONOHUE.

Serial No. 263900.

Appeal No. 85-868.

United States Court of Appeals,
Federal Circuit.

July 3, 1985.

Applicant appealed from a decision of the United States Patent and Trade Mark Office Board of Appeals which sustained final rejection of certain claims of an invention relating to acid compounds which were suitable for producing polymers used to form shaped objects such as film, fibers or molded parts. The Court of Appeals, Jack R. Miller, Senior Circuit Judge, held that the claims were properly rejected as anticipated.

Affirmed.

1. Patents ☐16(2, 3)

Prior art under 35 U.S.C.A. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it; such possession is effected if one of ordinary skill in the art could have combined publication's description of the inven-

* Judge Miller assumed senior status effective

tion with his own knowledge to make the claimed invention.

2. Patents ☐69

Even if claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling; however, it is not necessary that an invention disclosed in a publication actually be made in order to satisfy the enablement requirement. 35 U.S.C.A. § 102(b).

3. Courts ☐96(1)

Court of Appeals is bound by decisions of the Court of Customs and Patent Appeals.

4. Patents ☐72(1)

Anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.

5. Patents ☐72(1)

Claims of an invention relating to acid compounds which were suitable for producing polymers used to form shaped objects, such as film, fibers or molded parts, were properly rejected under 35 U.S.C.A. § 102(b) as anticipated.

William Magidson, of Chicago, Ill., argued for appellant.

Harris A. Pitlick, Associate Solicitor, U.S. Patent & Trademark Office, of Arlington, Va., argued for appellee. With him on the brief were Joseph F. Nakamura, Solicitor and John W. Dewhirst, Associate Solicitor, Washington, D.C.

Before MARKEY, Chief Judge, BALDWIN, Circuit Judge, and MILLER,* Senior Circuit Judge.

JACK R. MILLER, Senior Circuit Judge.

This is an appeal from the decision of the U.S. Patent and Trademark Office ("PTO") Board of Appeals ("board") sustaining the

June 6, 1985.

at reissue statutes, be construed lib- that a declaration January 26, 1981, after issuance of the February 14, 1978, ure its reissue ap- amount of "liberal- gard of the plain I do not regard *In* , 164 USPQ 218 s error." It is not for statute "in the public ince of Congress.

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APPLICATION OF DOLL

Cite as 419 F.2d 925 (1970)

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454, 42 CCPA 824 (1955), he points out that:

It is well settled that where patentability is predicated upon a change in a condition of a prior art process, as a change in concentration or the like, that change must at least be "critical" —i. e., it must lead to a new and unexpected result—"and the applicant has the burden of proving such criticality".

Arguing that the specification is equivocal on this point and that no comparative or other evidence has been proffered to show criticality, the solicitor maintains that "the appellant cannot rely for patentability on the maintenance of hydrochloric acid concentration within the claimed range."

[1, 2] We have considered appellant's arguments carefully. However, we consider the approach taken by the Patent Office to have been a rational one and, looking at the record as a whole, find no reversible error. Based on the factual determinations made by the examiner in considering the state of the prior art, a *prima facie* case was made out that the claimed invention was obvious. It became, therefore, incumbent upon the appellant to come forward with some sort of evidence indicating that the distinguishing limitations which he places on the claimed process are, indeed, "critical", i. e., that they lead to a new result which would not be expected by those of ordinary skill in the art. Appellant failed in carrying out this burden. Although he *alleged* that there were long-standing difficulties with the use of concentrated aqueous solutions of hydrochloric acid as a catalyst for the subject decomposition process, the assertion that none of ordinary skill in the art would not expect concentrated hydrochloric acid to work well, or would be led away from its use, which we feel was essential to appellant's case, was never satisfactorily proved to be true. The decision of the court of appeals is affirmed.

Affirmed.

57 CCPA

Application of Henri-Georges DOLL.

Patent Appeal No. 8223.

United States Court of Customs and Patent Appeals.

Jan. 8, 1970.

Appeal from a decision of the Patent Office Board of Appeals, Serial No. 694-700, affirming the examiner's rejection of claims in application for a reissue patent. The Court of Customs and Patent Appeals, Almond, J., held that under statute providing that no reissued patent shall be granted enlarging scope of claims of original patent unless applied for within two years from grant of original patent, "applied" refers to filing of application for patent and the statute does not prevent submission of original claims, broader than both the original patent claims and the original broadening reissue claims, more than two years after the grant.

Reversed.

1. Patents \Leftrightarrow 138(1)

Under statute providing that no reissued patent shall be granted enlarging scope of claims of original patent unless applied for within two years from grant of original patent, "applied" refers to filing of application for patent and the statute does not prevent submission of original claims, broader than both the original patent claims and the original broadening reissue claims, more than two years after the grant. 35 U.S.C.A. § 251.

2. Patents \Leftrightarrow 140

Reissue application oath which specified that none of the original patent claims afforded coverage of the scope possessed by original reissue claims and that claims of comparable scope were never presented during pendency of original application, sufficiently complied with patent office rule requiring statement "distinctly specifying the excess

EXHIBIT

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or insufficiency in the claims," where applicant subsequently added reissue claims even broader in scope. Patent Office Practice Rules, rule 175, 35 U.S.C.A. App.

Brumbaugh, Graves, Donohue & Raymond, New York City, attorneys of record, for appellant, Arthur S. Tenser, New York City, of counsel.

Joseph Schimmel, Washington, D.C., for Commissioner of Patents, Jere W. Sears, Washington, D.C., of counsel.

Before RICH, Acting Chief Judge, ALMOND, BALDWIN and LANE, Judges, and RAO, Chief Judge, sitting by designation.

ALMOND, Judge.

This appeal is from the decision of the Patent Office Board of Appeals affirming the examiner's rejection of claims 32-35, 42 and 43 in appellant's application for a reissue patent¹ on the grounds that the claims are barred by the fourth paragraph of 35 U.S.C. § 251 and not supported by an oath complying with Patent Office Rule 175.

The invention relates to method and apparatus for oil well logging, with which information about the nature of earth formations surrounding a borehole is obtained. More important than an understanding of the invention here is the history of the application before the Patent Office presenting the development of the issues before us. The following facts are not in dispute.

On October 31, 1957, a year and ten months after issuance of his original patent, appellant filed the instant reissue application with the 19 claims of the original patent and 12 additional claims (claims 20-31), *broader* than the 19 original claims, copied for interference purposes from a patent to one Waters. After termination of an interference arising from the above action, appellant pre-

sented, during ex parte prosecution, four claims (32-35) copied from a patent to one Piety. The date of submission of those claims was July 28, 1960. Subsequently, during the duly declared Piety interference, appellant presented claims 36-41 copied from a third patent to Alder. On October 16, 1962, claims 32-35 were amended and claims 42 and 43 were presented. No oath other than the original reissue application oath was of record prior to the board's decision. Claims 32-43 are conceded to be broader than any of the original patent claims. All claims were found by the board to be for the invention disclosed in the original patent, and claims 36-41 were further found to be more limited in scope than claim 20 submitted at the time of filing of the reissue application. Claims 32-35, 42 and 43, the only claims before us, are conceded by appellant to be "broader than the claims originally submitted with the appellant's timely filed application for a broadened reissue patent."

Thus, the issues presented for determination in this appeal are:

(1) Whether claims presented in a reissue application filed within two years of the original patent grant are barred by 35 U.S.C. § 251 when such claims are not submitted until more than two years after the grant and are broader in scope than both the original patent claims and the broadening reissue claims originally submitted, and

(2) Whether the reissue oath originally filed with the reissue application is adequate to support the newly submitted claims.

As a corollary to (2) above, appellant contends that an issue before us is whether the board erred in refusing to consider, on petition for reconsideration, whether the original reissue oath can be supplemented after the two-year statutory period prescribed by 35 U.S.C. § 251.

1. Serial No. 694,700 filed October 31, 1957 for reissue of patent No. 2,728,047 granted December 20, 1955 for "Method and

Apparatus for Logging Spontaneous Potentials in Wells."

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The essence of the Patent Office's position is set forth in the opinion of the board as follows:

The fourth paragraph of 35 U.S.C. § 251, which reads as follows:

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

makes no direct mention of an application. Thus, it seems to us that the language could just as well mean that no reissue patent shall be granted enlarging the scope of the claims of the original patent, unless said claims are applied for within two years of the grant of the original patent.

Patent Office Rule 175 requires the reissue oath to particularly specify the errors relied upon, which appellant has done in this case by referring particularly to Fig. 4 in his oath, and the fact that he had failed to claim the invention in the breadth set forth in claims 20 to 31, inclusive. Thus, it appears that the two-year period in which to file for broadened reissue claims is granted for the purpose of enabling the patentee to discover particular deficiencies in the breadth of the claims as originally granted, and not as a period in which to decide whether or not he should spread a net to catch any broad subject matter which he may later decide should have been captured.

* * * * *

* * * [Claims 32-35, 42 and 43] are drawn essentially to the uphole mechanisms shown in Figs. 4 and 5, and nowhere do they require the specific instrumentalities set forth in the reissue oath and the device covered by claim 20. Therefore, these claims stand without an adequate reissue oath, and as claims broader than the patent claims for which no reissue claim was made within the two-year period allowed by the statute.

In support of this position, the solicitor contends, are the decisions in *La*

Maur, Inc. v. *DeMert & Dougherty, Inc.*, 265 F.Supp. 961 (N.D.Ill.1965), aff'd at (7th Cir. 1966) and *Stohr et al. v. Brenner*, 157 USPQ 675 (D.D.C.1968), aff'd at 417 F.2d 1149 (D.C.Cir.1969). Among the district court's 23 "Conclusions of Law" in *La Maur* is:

19. The reissue claims are also invalid because they are broader than the original claims and broader than the reissue claims originally presented and the doubly broadened subject matter was not claimed until more than two years after the original patent had been granted. Title 35 U.S.C. Sec. 251.

To similar effect is the court's conclusion and holding in *Stohr*, involving "doubly broadened" claims presented in a reissue application filed more than four years after the original patent grant, such application alleged to be, however, a continuation of a reissue application filed within two years of the issue date of the patent. Neither appellate court made any reference to the above ground in their respective affirmances.

We agree with appellant that the above-cited decisions are of little assistance to us in deciding the issues squarely presented to this court. Neither opinion does more than acknowledge the issue and state a conclusion. No analysis pertinent thereto is set forth. In *La Maur* the conclusion of law is but one of many conclusions drawn in the main from those submitted by the prevailing party, and in *Stohr* other factors, possibly relevant, are present.

Although the language of 35 U.S.C. § 251 appears to us free of ambiguity, the above decisions, despite the absence of logic or rationale justifying the courts' interpretations of 35 U.S.C. § 251, have prompted us to consider the legislative history pertaining to the enactment of 35 U.S.C. § 251 to ascertain whether there was any intent contrary to the apparent meaning of the language therein.

Senate Report No. 1979 on H.R. 7794, the patent bill, 1952 U.S. Code Cong. & Adm. News, pp. 2394, 2419, repeats in substance House Report No. 1923 (p. 26) and explains the fourth paragraph of section 251 merely as follows (Report, p. 26):

A two year period of limitation on applying for broadened reissues is added, codifying the present rule of decision with a fixed period.

P. J. Federico, in his Commentary on the New Patent Law in 35 U.S.C.A. following page 1, states (page 44 of commentary):

The new statute enacts a fixed period of two years from the grant of the original patent, within which to apply for a reissue "enlarging the scope of the claims of the original patent." Such a reissue cannot be obtained on an application filed more than two years after the date of the original patent, and presumably is timely if applied for within two years as far as the reissue requirements are concerned.

[1] We are unable to ascertain from the above any intent similar to the interpretation placed on section 251 by the board. To the contrary, it appears clear that the language "applied for" refers to filing of an application. The solicitor further makes reference to rights of the public. We have considered that argument but believe it unnecessary to comment thereon in detail in view of our interpretation of section 251 except to note, as does appellant, that 35 U.S.C. 252 provides safeguards for the public

by virtue of its intervening rights provisions.

[2] With respect to the rejection based on lack of an adequate reissue oath, it appears to us from the language employed by the board in its opinion that the affirmance of that rejection was based substantially on the view that the claims were barred by 35 U.S.C. § 251. While Patent Office Rule 175 sets out requirements for reissue oaths, including that the applicant make a statement "distinctly specifying the excess or insufficiency in the claims," we do not see where there has been a lack of compliance therewith in this case. The original reissue application oath specifies:

None of the patent claims affords for the embodiment of Fig. 4 patent coverage of the scope possessed by claims 20-31, inclusive, which form part of the foregoing specification, nor were claims of comparable scope ever presented during the pendency of the original application on which said Letters Patent were granted.

If the claims on appeal are broader in scope than claims 20-31, originally presented, as all agree, it is clear that none of the patent claims afforded patent coverage of the scope of claims 32-35, 42 and 43 either. We are unable to perceive any other objections by the board to the oath in question. No particular defect has been singled out or commented upon by the board. On this record, we agree with appellant that the oath is adequate.

The decision of the board is, accordingly, reversed.

Reversed.

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